

REMARKS

Claims 1-32 are pending and have been examined in the present application. All of the claims have been rejected under 35 U.S.C. § 103(a) over Schutzer, (U.S. Patent 6,292,789) in view of Hilt (U.S. Patent 5,465,206) and further in view of Lowrey (U.S. Patent 6,374,229). All of the claims have further been rejected under 35 U.S.C. § 112, second paragraph. In light of the below remarks, reconsideration of the present application is respectfully requested.

In paragraph 3 of the Office Action, claims 1-32 have been rejected under § 103 over Schutzer in view of Hilt and further in view of Lowrey. Applicants respectfully traverse this rejection.

Independent claims 1 and 24 require “generating an electronic summary of the at least one bill using the detailed billing information, *the electronic summary being formatted in the form of a remittance slip*” and further require that “the electronic summary can be printed out to serve as a remittance slip in the traditional method of payment of the at least one bill by the at least one payer.”

Similarly, independent claim 19 requires “generating an email containing summary information regarding a bill owed by the at least one payer to the at least one payer, *the summary being formatted as a remittance slip.*”

None of Hilt, Schutzer or Lowrey teach or even suggest this feature of the independent claims of the present application. In fact, the Office Action does not even allege that any of these references teach this feature of the present invention.

As described in the present specification at pages 1 and 2, the prior art electronic bill paying systems suffered from the deficiency that payers were incapable of using such systems for receiving electronic bills and rendering payment via traditional methods, such as

payment by check. The present invention solves this problem by formatting a summary portion of the electronically presented bill in the form of a remittance slip. This remittance slip can then be printed out and remitted in a traditional manner such as with a check.

As none of Schutzer, Hilt nor Lowrey teaches or suggests these limitations of all of the independent claims of the present application, withdrawal of the rejection under § 103 is therefore respectfully requested.

In paragraph 6 of the Office Action, all of the claims have been rejected under the second paragraph of § 112. Specifically, the Office Action states that “[t]he claims are too broad to resolve a distinctive novel set of feature over the existing art.” Applicants respectfully traverse this rejection. As advised in MPEP § 2171, there are two separate requirements for claims under the second paragraph of § 112. The first requirement is that “the claims must set forth the subject matter that applicants regard as their invention.” Applicants respectfully submit that all of the claims of the present application set forth the subject matter which applicants regard as their invention.

The second requirement of § 112 second paragraph is that “the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.” MPEP § 2171 goes on to state that the second requirement is “evaluated in the context of whether the claim is definite – i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.” Applicants respectfully submit that all of the present claims are definite.

The rejection in the Office Action under the second paragraph of § 112 has not alleged that the Applicants have not set forth the subject matter of the invention, nor has the Office Action alleged that the claims are indefinite. Instead, the Office Action states that “[t]he claims are too broad to resolve a distinctive novel set of features over the existing art.” Applicants respectfully submit that this is not a proper rejection under the second paragraph of

§ 112. A rejection based on the novelty of the features over the existing art is properly a rejection under § 102, not the second paragraph of § 112.

As each of the claims of the present application is definite and set forth the subject matter which Applicants claim as their invention, Applicants respectfully submit all of the claims are in compliance with the second paragraph of § 112. Withdrawal of the rejection under § 112 is therefore requested.

Applicants have shown that all of the claims of the present application are patentably distinct over the combination of Schutzer, Hilt and Lowrey. Applicants have furthermore shown that all of the claims are in compliance with the second paragraph of § 112. As each of the claims are currently in condition for allowance, such action is earnestly solicited.

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Respectfully submitted,

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